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10/661,878	09/11/2003	Kevin J. Zilka	SVIPGP002B	8771

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EXAMINER
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MOONEYHAM, JANICE A

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3629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/661,878

Applicant(s)

ZILKA ET AL.

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13,18-20,44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13,18-20,44 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This is in response to the applicant's communication filed on September 21, 2007, wherein:

Claims 1-2, 4-13, 18-20 and 44-45 are currently pending;

Claims 1, 18, 19-20 and 44-45 have been amended.

#### ***Information Disclosure Statement***

2. The information disclosure statements (IDSs) submitted on 5/11/07, 6/19/07, and 8/10/07 are considered by the examiner.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the independent claims to include the limitation of displaying statistics regarding a number of the patents of the set in each category of technology ***in a first interface***, displaying first additional information associated with at least a portion of the patents of the set ***in a second interface***

***separate from the first interface*** upon the selection of an icon ***positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second,***

displaying second additional information associated with at least one of the patents of the list ***in a third interface separate from the first interface and the second interface*** upon the selection of an additional icon ***positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface***

The Examiner request that the applicant direct the Examiner to where there is support for the newly added limitations:

In the Response submitted on 9/21/07 the applicant directs the Examiner to Figures 13, 15-16 and the following quoted excerpts:

Page 29, lines 22-24, wherein the specification discloses:

It should be noted that the electronic versions of the report (those that are displayed utilizing a computer) may include interactive features to further analyze the data by drilling down into selected areas.

Page 32, lines 8-25 (this section read in conjunction with page 31 discloses):

Page 31- line 8 thru page 33, line 15:

In a similar manner, it should be noted that the selection of a particular technology group may produce a 2-D graph illustrating a comparison of each of the companies in the specific technology group, where the selection of a "bar" or related icon may indicate a list of patents owned by such company in the particular technology group, and further where the selection of one of the patents may produce specific information regarding such patent; in a manner similar to that will soon be set forth.

Of course, the interface 1380 of Figure 13B may be skipped by simply clicking the "bars" or related icon of the report 1350 of Figure 13A.

Figure 14 illustrates a method 1400 for providing a graphical user interface such as that of Figure 13 (or even that of Figures 13A-B) which is equipped for reporting on strategic intellectual property management. In operation 1402 a technology category page is displayed depicting a plurality of categories of technology utilizing a graphical user interface.

As set forth in the exemplary graphical user interface 1300 of Figure 13, the technology category page includes statistics regarding a plurality of intellectual property identifiers identifying intellectual property in each of the categories of technology. Also included is competing activity documentation describing a plurality of competing activities in each of the categories of technology. Note operation 1404. Of course, as mentioned before, competing patent data may also be included.

In operation 1406, a user may be allowed to select a summary icon on the graphical user interface 1300. In use, ***such icon may act as a link to another page which sets forth additional information.***

***Figure 15 illustrates an exemplary summary report 1500, in accordance with one embodiment. Such report 1500 may be displayed in response to the selection of the summary icon 1310 of one of the technology categories shown in the interface 1300 of Figure 13. In the alternative, such page may be generated in utilizing the report definition interface 1200 by selecting a particular technology category via pull-down window 1204, selecting all of the intellectual property identifiers via pull-down window 1202, and selecting a summary format type. Of course, the summary report 1500 may be generated in any desired manner.***

As shown, the summary report 1500 lists each of the intellectual property identifiers, each competing patent, and each instance of competing activity associated with the appropriate technology category. For reasons that will soon become apparent, ***each item in the lists 1502 may include a link to an additional page with more information.***

***In an alternate embodiment,*** an intellectual property identifier icon, competing patent icon, or a competing activity documentation icon may be selected separately. In such embodiment, the icons may include the bars 1304-8. Upon the selection of one such icons, only the intellectual property identifiers, competing patents, or competing activity documentation related to the particular technology category may be displayed, the intellectual property identifiers may be displayed. Note operation 1406.

With continuing reference to Figure 14, more information may be displayed regarding the intellectual property, the competing activity, and the competing patents in response to a user request in operation 1408.

In particular, upon a user selecting one of the intellectual property identifiers in the lists 1502, more information relating to such intellectual property may be presented. Figure 16 illustrates an exemplary intellectual property details report 1600, in accordance with one embodiment. As shown, a patent number, status, exemplary claim and figure, etc. may be provided in such report. It should be noted that such intellectual property details report 1600 may also be generated directly utilizing the report definition interface 1200 by selecting a particular intellectual property identifiers via pull-down window 1202, and selecting a details format type.

***Of course, the details report 1600 may be generated in any desired manner.***

Thus, while applicant's disclosure discloses that selection of one of the patents may product specific information regarding such patent, that the electronic version of the report may include interactive feature, a graphical user interface (GUI) which is equipped for reporting on IP management, that the user may be allowed to select a summary icon on the GUI wherein such icon may act as a link to another page which sets forth additional information, that a summary report may be displayed in response to the selection of the summary icon of one of the technology categories or that the page may be generated by selecting a pull-down window, and that the summary report may be generated in any desired manner, applicant's disclosure does not disclose displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second, displaying second additional information

associated with at least one of the patents of the list in a third interface separate from the first interface and second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface. At most applicant discloses that applicant may be allowed to select a summary icon on the GUI, such icon may act as a link to another page which sets forth additional information and that the summary report lists each of the intellectual property identifiers, each competing patent, etc. and that each item in the lists may include links to an additional page. Applicant also discloses that upon a user selecting one of the intellectual property identifiers, more information relating to the property may be presented. At most, an additional page or information is presented. However, there is no disclosure that the page is separate for the first of second information. Moreover, a page is not another interface or GUI.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The body of the claims have the following step:

storing the manually selected file in association with the at least one identifier by providing ***a correspondence between the file and the at least one***

***identifier, thus associating the manually selected file with the at least one identifier.***

First, it is not clear what applicant defines as a file. Second, what does the applicant mean by providing a correspondence between the file and the identifier. What is the applicant identifying as an identifier. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

This same step has the following language:

storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus ***associating*** the manually selected file with the at least one identifier, thus associating the manually selected file with the at least one identifier, ***wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents***

What does the applicant mean by associating the file with the identifier?

The applicant has a step of storing the manually entered notes in association with at least one identifier and then a step of allowing a selection of a file. Then the applicant states that a manually selected first file is associated with a first identifier corresponding to a single patent and a manually selected second



file is associated with a second identifier corresponding to a group involving a plurality of patents.

First, is the first identifier the same identifier that the notes were stored with? Secondly, the applicant states that the notes are stored in association with at least one identifier, requiring only one identifier. If there is only one identifier, how can there be a first and second identifier. Are these in addition to the identifier stored with the notes? Applicant states in the Response submitted on 9/21/07 that ***the claim language is purposefully drafted in a broad manner so not to be limited to a scenario where "the first identifier is the same identifier that the notes were stored with". In other words, it may or may not be and to specify one way or another would be unduly limiting to the claims*** (page 20).

Furthermore, the applicant has a step of allowing the manual selection of a file. If there is only one file, how can there be a first file and a second file? In response to this question, applicant responds by stating that ***regarding the second inquiry, the claims do not require "only one identifier," but rather "at least one"***. The Examiner asserts that this is non-responsive to the question.

The applicant has a step of ***associating a plurality of patents with the at least one identifier***. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

Thus, how can a plurality of patents be associated with one patent number? The applicant responds on page 21 of the response that applicant ***respectfully asserts that the claims are not limited to "a plurality of patents [being] associated with one patent number", as suggested by the Examiner. As noted by the Examiner, applicant's specification as originally filed expressly states that the "identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and or is associated with the intellectual property"***. The Examiner asserts that this is non-responsive to the question.

Although applicant states in the Response submitted on 9/21/07 that examples of such terms ("files", "identifier", "correspondence", "associated", etc) may be found in the figures below (Figure 11).

The applicant states in the preamble that the invention is a method for organizing patents. Then the applicant list the steps of displaying a notes field, storing the manually entered notes in association with an identifier, allowing the selection of a file, storing the file with the identifier and associating a plurality of patents with the identifier.

The applicant then adds the language "wherein the manually entered notes, at least one of the manually selected files, and the patents ***are accessible*** by subsequent selection of the at least one identifier. What does the applicant mean by accessible? ***Applicant response on page 21 to this question is that***

***applicant relies on the plain and ordinary meaning of "accessible"***. It is not clear what applicant is claiming in this step.

The applicant then has added the language that "wherein a set of patents is *reported* by – what does the applicant mean by "reported"? What set of patents are being reported? In response to this question, applicant states on page 21 that the ***applicant relies on the plain and ordinary meaning of "reported"***. The Examiner asserts that this is non-responsive to the question.

The applicant then states *displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface and displaying statistics regarding a number of patents of the set in each category of technology*.

While applicant has amended the claims to overcome the question of how can one category become each category? Applicant does not respond to the question of where does the technology mapping come from? The claim language up until now relates to notes fields and identifiers.

Applicant then claims displaying first additional information associated with at least a portion of patents of the set in a second interface separate from the first interface upon the selection an positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, the first information including a list of patents of the set associated with one category of technology, displaying a second additional wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, an exemplary figure information; wherein the

statistics are displayed in the first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface.

It is not clear how the set of patents being displayed is connected to the identifier or the file. It is unclear to the Examiner what the applicant is claiming in the claim language. **Applicant has started out with a notes field, storing the notes field with an identifier, selecting a file, storing the file, associating a plurality of patents with at least one identifier** (it is not clear where the plurality of patents come from since there is no search being performed), **making the notes and files and patents accessible by selection of the at least one identifier** (however, where is it in the claim language that the notes, files and patents where ever correlated with one identifier). **Applicant then states that a set of patents is reported** (however, it is not clear what set of patents or if the set of patents relate to any of the steps above), **displaying a technology mapping depicting a plurality of categories of technology** (note that the patents are not mentioned in this displaying step); **displaying statistics regarding a number of patents of the set in each category, displaying additional information in a second interface, wherein the first additional information includes a list of the patents of the set associated with one category of technology** (there is no earlier correlation with the technology mapping depicting at least one category of technology and a listing of patent), **displaying second information associated with at least one of the patents in the list in a third interface** (however, it is unclear where this list even comes

from), wherein the second information is selected from the group consisting of a patent number, a status, a claim or a figure. What does this mean? Your first information is information associated with patents and your second information is a patent number, status????).

In response to the above questions, applicant states that the ***claims have been clarified to avoid these issues***. The Examiner disagrees with this assertion.

The applicant states in the claim language "that wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail".

This is unclear. What does the applicant mean by "made accessible?" Are they transmitted?

In Claims 5 and 6, it is unclear what the applicant means by the language "the at least one identifier is determined utilizing an add icon" or "a modify icon".

In Claims 8 and 9, it is unclear what the applicant means by the file is selected utilizing a file structure field? What is a file structure field? What does the applicant mean by the file structure field includes a file tree structure?

In Claim 12, it is unclear what the applicant means by the patents associated with the at least one identifier are identified by searching a database of already existing identifiers. This is unclear. It is not clear what the applicant is searching or what the applicant is searching for.

In response to the above questions and statements, the applicant simply states (page 25 of the Response filed on 9/21/07) that applicant ***respectfully***

***relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary (and not even technical in nature). In response, applicant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.***

5. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what statutory class applicant is coming in for. A system can be an apparatus, whereby there would need to be some recitation of structure. Applicant identifies the invention as a system comprising a computer readable medium. However, applicant has not claimed the code as being on the medium. Thus, so far, the invention appears to be directed to a system comprising a computer readable medium. It is not clear what applicant identifies as a medium in the specification. Not all computer readable mediums are statutory, ie, signals, carrier waves. Thus, it is unclear what applicant is claiming in claim 20.

**The Examiner finds that because claim(s) 1-2, 4-13, 18-20, and 44-45 are replete with 35 U.S.C. 112 2<sup>nd</sup> paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2<sup>nd</sup> paragraph rejections, the claims are construed and the art is applied as *much as practically possible*.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-13, 18-20 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette) in view of Barnett et al (2002/0082778) (hereinafter referred to as Barnett).

Referring to Claims 1, 18, 19, 20, 44 and 45

Rivette discloses a method, computer program product embodied on a computer readable medium and a system (page 9 [0289-0291] page 10 [0294]) for organizing patents utilizing a computer-implemented system, comprising:

computer code for performing the steps of the method [0012] [0289], comprising:

displaying (display unit (1122) page 9 [0292]) a notes field for receiving manually entered notes and receiving the manually entered notes, utilizing the notes field (Fig. 4 Notes Mode (414) (Figure 134 (13408) [1200-1202] [0255-0257] Figs. 125-143 [0314] [0384] [0326]);

storing the manually entered notes in association with at least one identifier (patent number) (Fig. 111; Figure 134 save button [0380-0387]);

receiving the manual selection of a file ( [0373] [0383] Figure 134 (13404);

storing the manually selected file in association with the at least one identifier (patent number) by providing a correspondence between the file and the at least one identifier wherein a manually selected first file is capable of being associated with a first identifier (patent number) corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group (Figures 117-119 and Figures 133 and 134 (13304)

Analog Special Effects; [0264] a group is a data structure that includes a collection of patents [0326-0329] [0330-0344] [0373-0379] [0393]) ; and

associating a plurality of patents with the at least one identifier (Figure 122; [0265]);

wherein the manually entered notes and the patents are accessible by subsequent selection of the at least one identified (Figures 117-120, 122, 133, 134, [1157-1162] [0373-0387] [0329)

wherein a set of patents is reported by;

displaying a mapping depicting a plurality of technology utilizing a graphical user interface (page 2 [0025], page 7 [0262-0268]; pages 8-9 [0277] [0848] Figure 18 [1101-1110]),

displaying statistics regarding a number of the patents of the set in each category of technology ([0025] [0262] [0266] [0277] Figure 102-105),

displaying first additional information associated with at least a portion of the patents of the set upon the selection of an icon (Figs. 148, 117-120, 122, 133, 134, 153 [0377] [1157-1162]),



wherein the first additional information includes a list of patents of the set associated with one of the categories of technology ( [0020], [0262, 0264-0268], [0331] [1027-1028]),

displaying additional information associated with at least one of the patents of the list upon the selection of an additional icon, wherein the second additional information is selected from a group consisting of a patent number, status, an exemplary claim, and an exemplary figure ([0377], Fig. 7, Fig. 45 (4512), Figs. 111-112; Figure 148; [1157-1162]),

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface (Figs. 111-112, see also Figures 117-134);.

wherein said method is at least in part carried out utilizing the computer implemented system (Fig. 3-4); and wherein the method supports a drill down technique ([0270]).

Rivette displays interfaces showing different information relating to patents, wherein the interfaces have three interfaces (Figs. 57, 125, 117). Rivette discloses technology and competitor analysis [0262—0268]. However, Rivette does not explicitly disclose displaying a technology mapping (although page 2 [0025] does not exclude technology mapping) depicting at least one category of technology or wherein the first additional information includes a list of patents of the set associated with one category of technology, or wherein there is second additional information selected from the group consisting of a patent

number, status, exemplary claim or figure, or wherein the statistics are displayed in a first interface, the first additional information is displayed in the second interface, and the second additional information is displayed in a third interface.

However, Barnett disclose depicting at least one category of technology and the first additional information includes a list of patents of the set associated with one category of technology, and wherein there is second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, and wherein the statistics are displayed (Figures 21-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the patent method and system of Rivette the technology mapping disclosed in Barnett to aid in strategic and tactical business decisions.

The Examiner notes the following as to interpreting the claim limitations:

The statement that "wherein the manually entered notes, at least one of the manually selected files and the patents are accessible by subsequent selection of the at least one identifier" does not provide for a positive recitation of accessing the notes, files or patents, nor is there a positive recitation of the at least one identifier being selected and thus this language is merely non-functional descriptive data.

The recitation of "wherein the notes field allows a user to cut and paste notes" is only descriptive of the notes field. There is no positive recitation of the user cutting and pasting notes in the notes field.

The recitation "wherein the file is selected utilizing a file structure field including a file tree structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file selected utilizing the file tree-structure including information from a source separate from the patents" does not provide a positive recitation of a file being selected. The fact that the file structure field includes a file tree structure is non-functional descriptive data. The fact that the file tree structure allows a user to browse various folders is not a positive recitation of folders actually being browsed. There is no positive recitation of displaying the file structure simultaneously with the notes field. Moreover, the fact that the file tree structure includes information from a source separate from the patents is non-functional descriptive data.

As for the limitation of "wherein the patents associated with the at least one identifier are identified by searching a database including a comprehensive database of all patents issued by at least one government agency is non-functional descriptive data.

As for the limitation "wherein a set of the patents is reported by:  
displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface,  
displaying statistics regarding a number of patents of the set in each of the categories of technology in a first interface;  
displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon

the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the additional information includes a list of patents of the set associated with the one of the categories of technology;

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim and an exemplary figure" the Examiner asserts the following:

All that the is required by the claim limitations is displaying a technology mapping depicting a plurality of categories of technology, displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface".

Moreover, many of the differences between the prior art and applicant's claimed invention are deemed to be non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter.

See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying what is displayed in the record adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying what is in the record does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The fact that the notes and files are made accessible to other parties utilizing e-mail is old and well known. Furthermore, because of the way this step is worded, it could encompass a person e-mailing another person to come look at the notes and files.

E-mail, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be attaching a file and emailing it to another computer or simply having a hyperlink in the email. Industry has utilized computers for years as a way of tracking and documenting information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize e-mail as a way of communication since it is fast and efficient and reliable way of communication.

Furthermore, applicant's disclosure states that the summary report 1500 may be generated in any desired manner and the details of report 1600 may be generated in any desired manner (page 32, lines 14-15 and page 33, line 15).

Thus, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to display the report as Rivette and Barnett have since applicant has not disclosed that displaying the

report as applicant now claims provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected applicant's invention to perform equally well with the reports and the details of the reports being generated in any desired manner, as set forth by application.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the reports and the details of the reports in any desired manner since, as applicant admits above, there is no advantage, particular purpose, or solution to a problem being solved.

Referring to Claims 2, 4-6:

Rivette discloses a method wherein the at least one identifier is determined by selecting an already existing identifier (Figure 147 and 117-120, 133-134).

Furthermore, it is old and well known to have a method wherein the at least one identifier is determined by selecting an already existing identifier utilizing a pull-down menu. For example, while doing a search in East, the Examiner may use a number from a pull down menu to select a search and then store this search as a new search.

It is also old and well known to add a file and thus create a new file with a new identifier or modify the name to a file thus creating a new identifier.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a pull-down menu, an add icon or a modify icon to the disclosure of Rivette so as to allow for easy access to the identifiers.

Referring to Claims 7-11:

Rivette discloses wherein a notes field allows a user to cut and paste notes (Fig. 58, Fig. 137 (Note ToolBar (13706)), wherein the file is selected utilizing a file structure field (Fig. 58), wherein the file structure field includes a file tree structure (Fig. 58), wherein the file structure field allows a user to browse various folders where files have been previously stored, Fig. 58), and wherein the file structure is displayed simultaneously with the notes field on the same interface (Fig. 58 Figures 117-120, 133-134, [1157-1162], [1193].

Referring to Claim 12:

Rivette discloses wherein the patents associated with the at least one identifier are identified by searching a database of already existing identifiers (Fig. 6, Figs. 12B-12L, Figure 148).

Referring to Claim 13:

Rivette discloses wherein the database is a comprehensive database of all patents issued by at least one government agency (Document database [0310-0311], Patent bibliographic database [0318-0322] [0806-0807] [0418-0422] [0388-0417])



***Response to Arguments***

Applicant's arguments filed September 11, 2003 have been fully considered but they are not persuasive. The Examiner has addressed most of applicant's arguments in the body of the rejection.

**NOTE:** As to the rejection of claims 1-2, 4-13, 18-20, and 44-45 under 35 USC 103(a) as being unpatentable over Rivette in view of Barnett, the Examiner notes that applicant only argues the following limitations:

displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,

displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology,

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure" (as amended-see this or similar, but not necessarily identical language in the independent claims).

Wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.

Wherein the at least one identifier is determined by selecting an already-existing identifier (claim 2).

Wherein the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu (claim 4).

Wherein the at least one identifier is determined utilizing an add icon (claim 5).

Wherein the at least one identifier is determined utilizing a modify icon (claim 6).

Wherein the notes field allows a user to cut and paste (claim 7).

Thus, the Examiner asserts that all of the following limitations in independent claims 1, 18, 19, 20, 44 and 45 are met by the prior art as well as dependent claims 8-13:

- displaying a notes field for receiving manually entered notes including text; receiving the manually entered notes, utilizing the notes field;

- storing the manually entered notes in association with at least one identifier, thus associating the manually entered notes with the at least one identifier;

- [[allowing]]receiving the manual selection of a file;

- storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and

- associating a plurality of patents with the at least one identifier;

- wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier;

- wherein the notes field allows a user to cut and paste notes;

wherein the file is selected utilizing a file structure field including a file tree-structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file selected utilizing the file tree-structure including information from a source separate from the patents;

wherein the patents associated with the at least one identifier are identified by searching a database including a comprehensive database of all patents issued by at least one government agency;

As well as:

an identifier object;

a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object;

at least one file object correlated with the identifier object by providing a correspondence between the file object and the identifier object, for tracking manually selected files associated with the identifier object, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and

at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object;

As for applicant's traversal of the Official Notice taken in claims 4-6 the Examiner notes the following:

A "traverse" is a denial of an opposing party's allegations of fact.<sup>1</sup> The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as

constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971). If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following are admitted prior art:

wherein notes and files are made accessible to other parties utilizing e-mail.

wherein the at least one identifier is determined by selecting an already existing identifier utilizing a pull-down menu.

wherein the at least one identifier is determined utilizing an add icon

wherein the at least one identifier is determined utilizing a modify icon

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<sup>1</sup> Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

Applicant states that the Examiner has argued that Figures 111-112 of Rivette meet applicant's claimed "displaying statistics in a first interface, displaying first additional information in a second interface and displaying additional information in a third interface. However, applicant asserts that the description of Figures 111-112 only state that Figure 111 is an example display format showing the display of patent text in a first window (first interface) and notes in a second window (second interface). Moreover, the applicant is directed to the discussion in the rejection wherein other Figures and paragraphs are cited. The Examiner asserts that Rivette in combination with Barnett disclose this limitation.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

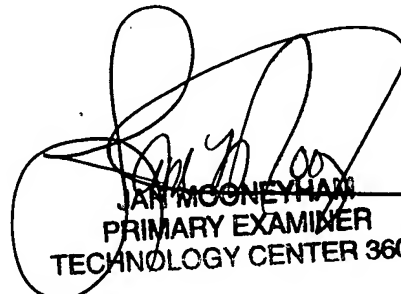
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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